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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,329	07/13/2001	Jonathan David Goodwin	41543/RRT/S850	6970
23363	7590	11/17/2006	EXAMINER	
CHRISTIE, PARKER & HALE, LLP			BORISSOV, IGOR N	
PO BOX 7068			ART UNIT	
PASADENA, CA 91109-7068			PAPER NUMBER	
			3628	

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,329

Applicant(s)

GOODWIN ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 7-68 is/are pending in the application.
- 4a) Of the above claim(s) 43-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 7-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____


IGOR N. BORISSOV
PRIMARY EXAMINER

DETAILED ACTION

Response to Amendment

Amendment received on 4/11/2006 is acknowledged and entered. Claims 2 and 6 have been canceled. Claims 1, 3, 4, 15-18 and 23 have been amended. Claims 43-68 have been withdrawn. Claims 1, 3-5 and 7-42 are currently pending in the application.

Examiner's statement

Amended Claim 23 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- A. Claims 1, 3-5 and 7-22 drawn to a postage printing system comprising means for downloading printing software over the Internet, classified in class 705, subclass 60.
- B. Claims 23-42 drawn to a system for providing a user with a plurality of service plans and for allowing the user to change the selected service plan, classified in class 705, subclass 400.

Inventions A and B are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention B has utility separate from that of inventions A such as selecting a flat monthly rate for services rendered. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, or patentability requirements, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 23-68 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, claim 16 includes the following limitation, which is not supported by the specification: "... wherein the GUI for managing the printing comprises of a first GUI for printing a *quality assurance postage*."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-5 and 7-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 refers to an apparatus, and recites the following limitations: "a graphical user interface (GUI) for installing software for printing the postage; a GUI for registering the user in the system; a GUI for managing the printing of the postage;" which is confusing. It is not clear to what extent a GUI represents a structural element. Furthermore, the claim is written in means plus function format, which is confusing. It is not clear how a GUI can provide for "installing software" or "managing the printing". Furthermore, said limitations of "installing" or "managing" indicates method steps, while the claim is directed to an apparatus.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 7, 8, 11-15 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara (US 6,233,568).

Claim 1. Kara teaches a web-enabled system for printing postage on a mail piece comprising:

a web-enabled client subsystem (Fig. 1A; C. 11, L. 29-31; C. 17, L. 52) for interfacing with a user comprising:

a graphical user interface (GUI) for installing software for printing the postage (Fig. 2);

a GUI for registering the user in the system (Fig. 3A);

a GUI for managing the printing of the postage (Figs. 4A-4O);

a server subsystem capable of communicating with the client subsystem over the Internet for authorizing the client subsystem to print the postage (C. 7, L. 47 – C. 8, L. 9).

Kara does not specifically teach providing insurance service based on type of a mail piece selected by the user.

However, Kara teaches providing user with ability to select a mail piece, and providing insurance service among other services (Figs. 4A-4O; C. 5, L. 63).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara to include providing insurance service based on type of a mail piece selected by the user, as suggested in Kara, because it would advantageously allow to provide a system which may be managed by a single

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service provider for providing various services, as specifically stated in Kara (C. 4. L. 15-19).

Claims 3, 4, 7, 11, 15 and 20-22, see reasoning applied to claim 1.

Claim 5. The use of computer for calculating an amount due for a selected service indicates the use of certain logic or business rules.

Claim 8. Kara teaches that the client subsystem further comprises a GUI for specifying an address book from a plurality of address (C. 19, L. 55-62).

Claims 12-14, the use of the Internet suggests browsing the Web including on-line shopping.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara in view of Cordery et al. (US 5,454,038).

Claims 9 and 10. Kara teaches all the limitations of claims 9 and 10, except that the client subsystem further comprises an address matching module for verifying an address entered by the user.

Cordery et al. (Cordery) teaches an electronic data interchange postage evidencing system, including a postage hygiene module for determining if an exact match was found for a particular record (C. 12, L. 1-5).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara to include that the client subsystem further comprises an address matching module for verifying an address entered by the user, as disclosed in Cordery, because it would advantageously allow to avoid undelivered mail.

Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara in view of Ryan, Jr. et al. (US 5,871,288).

Claims 16-18. Kara teaches all the limitations of claims 16-18, except that said GUI includes a first GUI for printing a quality assurance postage indicia.

Ryan, Jr. et al. (Ryan) teaches a system for generating and printing information based indicia in postage metering system, wherein a test print is conducted and inspected for errors, at which point a user can either accept the print, or reject it (C. 3, L. 28).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara to include that said GUI includes a first GUI for printing quality assurance postage indicia, as disclosed in Ryan, because it would advantageously allow to avoid printing wrong information, thereby save funds.

Claim 19. Ryan teaches said system, wherein the GUI for managing the printing comprises of a GUI for troubleshooting selected printing options (C. 3, L. 52-63).

Conclusion

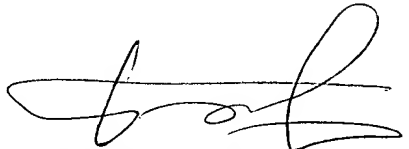
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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11/11/2006



IGOR N. BORISSOV
PRIMARY EXAMINER